

ESTTA Tracking number: **ESTTA748708**

Filing date: **05/26/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223497
Party	Defendant Buglisi Recobs Group LLC
Correspondence Address	PATRICK C O'REILLY LIPSITZ GREEN SCIME CAMBRIA LLP 42 DELAWARE AVENUE, SUITE 120 BUFFALO, NY 14202 UNITED STATES poreilly@lglaw.com
Submission	Motion to Reopen
Filer's Name	Patrick C. O'Reilly
Filer's e-mail	poreilly@lglaw.com
Signature	/Patrick C. O'Reilly/
Date	05/26/2016
Attachments	No- tice_of_Motion_for_Enlargment_of_Scheduling_Order_to_Allow_Discovery.PDF (30553 bytes) Affirmation_in_Support_of_Motion_for_Enlargement.PDF(94917 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

Applicant

**NOTICE OF MOTION FOR
ENLARGMENT OF SCHEDULING
ORDER TO ALLOW DISCOVERY
Opposition No. 91223497
Serial No. 86/415,114**

PLEASE TAKE NOTICE, that a motion will be made for the relief specified herein in connection with the above-entitled action as follows:

MOVING PARTY: Applicant, BUGLISI RECOBS GROUP, LLC

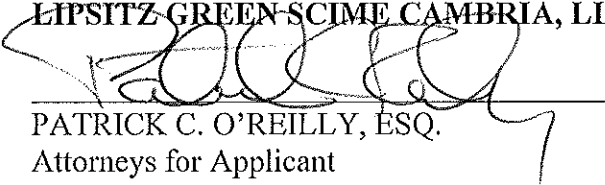
PLACE: PATENT AND TRADEMARK OFFICE

**RELIEF SOUGHT AND
GROUNDS THEREFORE:** An Order enlarging and extending the discovery deadline contained in the Scheduling Order of August 25, 2015 to permit discovery for brief Period subsequent to the determination of Applicant's pending motion to amend its answer

SUPPORTING PAPERS: This Notice of Motion and Affidavit of Patrick C. O'Reilly, Esq.

DATED: Buffalo, NY
May 26, 2016

LIPSITZ GREEN SCIME CAMBRIA, LLP


PATRICK C. O'REILLY, ESQ.

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AFFIRMATION

Opposition No. 91223497
Serial No. 86/415,114

PATRICK C. O'REILLY, ESQ., being duly sworn, deposes and says:

1. I am the attorney of record for the co-Applicant, Buglisi Recobs Group, LLC in the above entitled opposition action and submit this affirmation in support of Applicant's Notice of Motion for enlargement of the Court's Scheduling Order.

2. On August 26, 2015, Opposer, Jim Beam Brands Co. ("Opposer") filed a Notice of Opposition contesting the registration of Applicant's mark MISTER GINGER ("Notice of Opposition").

3. That same day, the Trademark Trial and Appeal Board ("TTAB") set a "Conference, Discovery and Trial Schedule" ("Scheduling Order") which set discovery to close on May 2, 2016.

4. On October 2, 2015, Applicant filed an Answer to the Notice of Opposition.

5. Admittedly, Applicant underwent a change of counsel in the early stages of the registration process, and a review of previous submissions filed by prior counsel revealed that there was a mistake in content.

6. In fact, the product that Applicant is attempting to garner trademark registration for is a ginger-spiced whiskey, which is exceedingly different from Opposer's product, which is an Irish unflavored whiskey.

1 7. However, at the time the Opposer filed the Notice of Opposition, the TTAB's record
2 listed Applicant's product as having no ginger characteristic.

3 8. As such, my offices notified the TTAB of the mistake, and explained to Opposer's
4 counsel that the products were inherently different.

5 9. At that time, it was my understanding that counsel for both parties were discussing
6 settlement since the mistaken submission was retracted and the difference in the products was
7 made exceedingly clear.

8 10. In fact, during the discovery phase, research revealed that Opposer previously filed a
9 formal written response to an Office Action issued February 28, 2011 in connection with
10 Opposer's Application to register "2 GINGERS" ("Opposer's Response") which made statements
11 of fact and law which would adamantly refute any suggestion of likelihood of confusion since the
12 products are so different.

13 11. On April 6, 2016, when it became apparent that settlement was not moving forward on
14 Opposer's end, Applicant filed a Motion to Amend its Answer to include an additional affirmative
15 defense and a counterclaim incorporating the arguments contained in Opposer's Response.

16 12. The Motion to Amend Applicant's Answer is currently pending.

17 13. As counsel of record, I concede that any motion for enlargement of the discovery period
18 should have been filed concurrently with the Applicant's motion to Amend its Answer.

19 14. Unfortunately, at the time the Motion to Amend was filed, I was out of town for a
20 months' time, and had not considered the possible issues with the discovery deadline.

21 15. Applicant has been unable to serve discovery demands upon Opposer prior to the
22 expiration of the discovery deadline, and herein petitions the Board for an enlargement of the
23 Scheduling Order in order to allow it the opportunity to adequately explore the merits of the
24 underlying action for a brief period subsequent to the determination of the pending motion to
25 amend Applicant's answer.

26 16. Just days before the close of discovery, Opposer filed a battery of discovery demands
27 which, by their terms, are still executory and pending.

1 17. It is submitted that, the extension would cause no prejudice to the Opposer, as it is the
2 party enjoying trademark protection on the principal registrar, while Applicant is being prevented
3 from finalizing its product packaging or launch date.

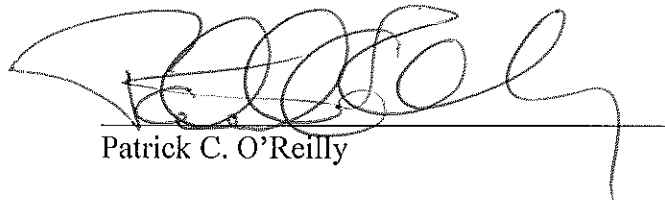
4 18. Further, the burden of proof is on the Opposer, and as such it must submit evidence to
5 the TTAB in support its claims of likelihood of confusion, which would constitute the primary
6 topic area addressed in Applicant's discovery demands.

7 19. Counsel previously requested a stipulation from Opposer's counsel to enlarge the
8 Scheduling Order, but was denied that request.

9 20. For all the foregoing reasons, Applicant submits that the circumstances constitute the
10 more stringent standard of excusable neglect, and an enlargement of the Scheduling Order is
11 proper.

12 WHEREFORE, your deponent respectfully requests that the Board grant the relief
13 requested in the annexed Notice of Motion.

14
15 Dated:


Patrick C. O'Reilly